

REMARKS

I. Summary of the Examiner's Action

A. Claim Rejections

As set forth in paragraph 5 on page 3 of the April 16 Office Action, claims 1 – 12, 14 – 17, 19 – 23, 26 – 31 and 43 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent No. 6,594,503 B1 to Herzig *et al.* (hereinafter “Herzig” or “the Herzig patent”).

As set forth in paragraph 7 on page 8 of the April 16 Office Action, claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view of International Application No. WO 99/17230 to Schlasberg (hereinafter “Schlasberg” or “the Schlasberg application”).

As set forth in paragraph 8 on page 9 of the April 16 Office Action, claims 24 – 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view of United States Patent No. 6,707,581 B1 to Browning (hereinafter “Browning” or “the Browning patent”).

As set forth in paragraph 9 on page 10 of the April 16 Office Action, claims 32 – 37 and 40 – 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Herzig patent in view of United States Patent Application Publication No. 2002/0140993

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A1 to Silverberg (hereinafter “Silverberg” or “the Silverberg application”) and further in view of DE010158358351A1 to Schultheis (hereinafter “Schultheis”).

As set forth in paragraph 10 on page 13 of the April 16 Office Action, claim 38 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Herzog, Silverbrook and Schultheis and further in view of Schlasberg.

As set forth in paragraph 11 on page 13 of the April 16 Office Action, claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Herzog in view of Silverbrook and Schultheis and further in view of United States Patent No. 6,741,864 B2 to Wilcock et al. (hereinafter “Wilcock” or “the Wilcock patent”).

II. Applicant’s Response – Election Requirement

Applicant’s Representative hereby affirms the election of claims 1 – 43 (Group 1) that were provisionally elected in a teleconference with the Examiner that occurred on April 6, 2007. Applicant has cancelled claims 44 – 45 (Group II), but respectively reserves the right to pursue these claims in one or more divisional applications.

III. Applicant’s Response – Claim Rejections

A. Rejection under 35 U.S.C. §§ 102(e) and 103(a)

Applicant reproduces claim 1 (as amended) here as a convenience to the Examiner:

1. An electronic device comprising:

data reading means operable to read metadata carried by an image carrier which carries a printed image;

interpretation means operable to interpret the metadata to identify an instruction for operation of the device;

execution means operable to cause the device to execute an instruction identified by the interpretation means; and

an image system comprising:

image means operable to receive data representing an image;

metadata means operable to generate metadata able to be interpreted to identify an instruction of the electronic device, and to associate the metadata with the image data; and

data output means operable to output image data and associated metadata for generating a printed image which incorporates the metadata in a form readable by the electronic device,

where the electronic device is a hand portable electronic device.

Claim 1 has been amended to recite the subject matter of claim 18 (now cancelled, along with claims 2 and 19 – 21). Applicants respectfully submit that it is not seen where the subject matter of claim 1, as amended, is either described or suggested by the art of record. It is noted that Examiner did not advance a basis of rejection for claim 18.

Support for the amendment of claim 1 can be found, for example, beginning at page 10, line 5 of the specification, which states that “Fig. 4 illustrates an imaging system

60 used to generate a document 40 having a printed image 36 and machine readable metadata 42, as described above. The system 60 includes at least one device which can receive data representing an image. In this example, the device may be a hand portable electronic device such as the telephone described above in relation to Fig. 1 ...”

Accordingly, since the art of record neither describes nor suggests the combination of elements reflected in claim 1, Applicant submits that claim 1 is patentable and should be allowed. As a result, Applicant respectfully submits that the rejection of claim 1 be withdrawn. Applicant also submits that claims 3 – 17 and 22 – 42 are allowable both as depending, either directly or indirectly, on an allowable base claim, and for reasons having to do with their independently-recited features. Applicant therefore respectfully requests that the rejection of claims 3 – 13 and 22 – 42 be withdrawn.

Regarding the rejection of claim 43, Applicant understands Herzog to disclose a telephone number in the relied-upon portion of Herzog, which is not “an instruction” as is required by claim 43. Accordingly, Applicant respectfully requests that the rejection of claim 43 be withdrawn.

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IV. Conclusion

The Applicant submits that in light of the foregoing remarks and amendments the application is now in condition for allowance. Applicant therefore respectfully requests that the outstanding rejections be withdrawn and that the case be passed to issuance.

Respectfully submitted,

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Date

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